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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,635	11/02/2001	Joseph C. Salamone	P02866	8360

7590 09/23/2003
Bausch & Lomb Inc.
One Bausch & Lomb Place
Rochester, NY 14604-2701

12
EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/003,635

Applicant(s)

SALAMONE ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/11/03 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Applicants' amendment and supplemental information disclosure statement filed on July 11, 2003 and May 14, 2003, respectively, were received. Claims 7-10 and 19-27 are amended.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 7).

Claim Objection

4. Objection of Claim 7-13 and 19-28 is maintained because the rejection is adequately set forth in paragraph 5 of Paper No. 7.

Claim Rejections - 35 USC § 102

5. Rejection of Claims 7-13 and 19-28 under 35 USC 102(b) as being anticipated by Toyashima (US 4 954 586) or Gaylord (US 3 808 178) is maintained because the rejection is adequately set forth in paragraphs 7 and 8 of Paper No. 7.

Responsive to arguments regarding claim objection

6. Applicants alleged that the instant claims had been amended to obviate the informality issue regarding the terms "alkyl", etc. However, the amendment was actually not done.

Responsive to arguments regarding 35 USC § 102 rejection

7. Applicant's arguments filed on July 11, 2003 have been fully considered but they are not persuasive.

The Applicants' principal argument against the rejection is that a) "The compositions of the present invention have desirable characteristics without the need for a fluorine containing (meth)acrylate and a polysiloxane macromonomer having polymerizable groups bonded via one or two urethane bonds to the siloxane main chain as is described by Toyoshima." and b) ...the present invention are produced from siloxysiloxane monomers having aromatic-based substituents, rather than simple phenyl groups. ...The same is not described by Gaylord."

Applicants' argument is not persuasive because of the following reasons:

With respect to a) Toyashima discloses a polymeric composition comprising tris(trimethylsiloxy)silylpropyl (meth)acrylate (i.e., reads on "one or more monomers" wherein z is 0, and R¹ is methyl, X is propylene and R is (meth)acryloxy) (col. 11, line 65-66) and components (A) to (D) (col. 3, line 14 to col. 4, line 35). Note that "comprising" recited in Claim 7 is an open-type transition phrase, which does not exclude the presence of other components. Therefore, the argument related to the use of a fluorine containing (meth)acrylate and a polysiloxane macromonomer having polymerizable groups bonded via one or two urethane bonds to the siloxane main chain in Toyashima's composition is irrelevant.

With respect to b), note that the present invention does claim the use of a siloxysilane monomer wherein R₁ can be a C₆ aryl (i.e., a phenyl) (see Specification, page 11, lines 11-12). Furthermore, Examiner cannot find a basis for the term "aromatic-based substituents" in the specification.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
September 16, 2003

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